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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,714	01/28/2005	Makoto Nakagawa	122553	8850
25944 7590 11/13/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
THROWER, LARRY W				
ART UNIT		PAPER NUMBER		
1791				
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11/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,714

**Applicant(s)**

NAKAGAWA, MAKOTO

**Examiner**

LARRY THROWER

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group I, Species B, claims 1-3 and 5-13 in the reply filed on September 29, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.
3. Claims 11-20 are cancelled by Applicant; claims 1-3 and 5-10 are under examination.

***Response to Amendment***

4. Claim 1 is amended; claims 11-20 are cancelled by Applicant; claims 1-3 and 5-10 are under examination. No new matter was entered.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claim 1** is rejected under 35 U.S.C. 102(b) as anticipated by Makoto (JP-2002-221696).

- Regarding **claim 1**, Makoto discloses a hydrating case having a containment recess for containing therein a moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess in order to absorb water and swell (abstract). The hydrating case includes a concave area on an inside face of the containment recess on which the moisture-containing contact lens rests formed as a concave bowed face having a curvature generally equivalent to that of a front surface of the moisture-containing contact lens (fig. 2), and a depression that opens out onto the concave bowed face formed in order to create a gap between the moisture-containing contact lens and the containment recess so that when the hydrating liquid flows down along the concave inside face (fig. 1; note that the grooves in fig. 1 of Makoto are formed in the circumferential direction that open out onto the concave bowed face, which are identical to the grooves in fig. 8 of the instant application [fig. 8 and ¶ 128 of US 2005/0126940] meeting this limitation of the claim), the hydrating liquid enters the gap; wherein a mating portion is formed in a rim of a mouth of the containment recess (fig. 2), and a cover is detachably attached by being mated with the mating portion (fig. 2), the cover has a tube through-hole formed therein (21), and a supply tube for supplying the hydrating liquid to the containment recess is inserted through the tube through-hole so that when the containment recess is covered by the cover (33), the hydrating liquid is supplied to the containment recess through the supply tube (fig. 3), and the mouth of the containment recess is provided with a liquid tight closure so as to constitute a distribution case in which the moisture-containing contact lens is sealed within the

containment recess while being in a state of immersion in a distribution storage liquid (¶ 21).

- As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Makoto.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

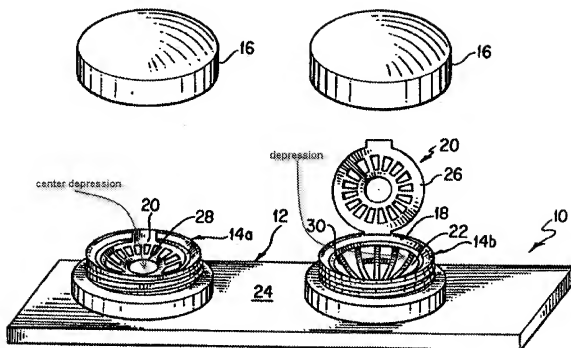
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-3 and 5-10** are rejected under 35 U.S.C. 103(a) as obvious over Makoto (JP-2002-221696) in view of Tsao (US 5,383,550).

- Regarding **claim 1**, Makoto discloses each and every element of claim 1, as recited above. Alternatively, in the event Makoto is not deemed to have a depression that opens out onto the concave bowed face, Tsao renders this feature obvious. Tsao discloses a contact lens case (10; fig. 2) having a containment recess (14) for containing therein a moisture-containing contact lens (lens; fig. 3), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (col. 2, lines 30-32), which is capable of allowing the contact lens to absorb water and swell. The case has an area of a concave inside face (22) of the containment recess (14) on which the moisture-

containing contact lens is capable of resting. The concave inside face (22) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (fig. 3). The case also includes a depression (see marked-up illustration below) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (lens; fig. 3) and the concave face (22; fig. 3) so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap.

- As taught by Tsao, when the contact lens is placed on the ribs of the containment recess, both sides of the lens are capable of being contacted by the solution (col. 3, lines 3-16; col. 1, lines 63-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the contact lens case of Makoto with the depression in the contact lens case of Tsao to allow solution to reach both sides of the lens, as taught by Tsao. As both Makoto and Tsao are concerned with the same problem of minimizing handling of a contact lens and providing adequate solution to both sides of the lens.



- Regarding **claim 2**, Tsao discloses the depression (illustration above) that is formed in such a way that, when the moisture-containing contact lens is placed on the concave bowed face (22) of the containment recess (14), the gap formed between the moisture-containing contact lens and the containment recess has an opening that opens to an outer peripheral side of the moisture-containing contact lens, and extends continuously diametrically inward from the opening (figs. 1 and 3).
- Regarding **claim 3**, Tsao discloses the depression being formed by at least one groove (figs. 1 and 3; col. 2, lines 59-65).
- Regarding **claim 5**, Tsao discloses the grooves forming a pattern extending in the diametrical direction of the concave bowed face (fig. 1).

- Regarding **claims 6-7**, Makoto and Tsao fail to disclose the specific groove depth dimensions and area depression ratios of claims 6-7. However, absent a showing of unexpected benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined, by routine experimentation, suitable groove dimensions to allow the lens to rest upon and provide adequate hydration and circulation of fluid to the lens as suggested by Tsao in col. 1, lines 63-65.
- Regarding **claim 8**, as disclosed by Tsao in col 2, line 66 - col. 3, line 2, when the device of Tsao is used as a case, the lens can be placed on the basket (20) which is capable of functioning as a containment recess and covered with saline. Thus, a center having no grooves is formed in a center portion of the concave bowed face so that a center portion of the moisture-containing contact lens is superimposed over an entire face of the center portion. Support is capable of being provided by the ribs (30) on the underlying surface.
- Regarding **claim 9**, as disclosed by Tsao in col 2, line 66 - col. 3, line 2, when the device of Tsao is used as a case, the lens can be placed on the basket (20) which is capable of functioning as a containment recess and covered with saline. Thus, a center depression is formed in a center portion of the containment recess (see illustration above) so that a lens center is capable of being supported floating above the containment recess by the center depression (see illustration below).
- Regarding **claim 10**, Tsao discloses both the concave bowed face and a bottom face of the depression having smooth, generally mirrored surfaces (fig. 3).



***Response to Arguments***

9. Applicant's arguments with respect to claims 1-3 and 5-10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LARRY THROWER** whose telephone number is 571-270-5517. The examiner can normally be reached on Monday through Friday from 9:30AM-6PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/  
Examiner, Art Unit 1791

/Christina Johnson/  
Supervisory Patent Examiner, Art Unit 1791